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10/686,955	10/15/2003	Mitch Fredrick Singer	113748-4836US	8821
27189 7590 03/26/2010 PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101				
EXAMINER MURDOUGH, JOSHUA A				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 03/26/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@procopio.com  
PTONotifications@procopio.com

## **ADVISORY ACTION**

### ***Acknowledgements***

1. This action is responsive to Applicants' IDS on 12 January 2010 amendments on 24 February 2010, and IDS on 5 March 2010.
2. This action has been assigned paper number 20100322 for reference purposes only.
3. Claims 1-20 and 39 are pending.
4. Claim 39 is withdrawn.
5. A new claim 71 was presented in the 24 February 2010 amendment, but has not been entered.

### ***After Final Submissions***

6. Applicants after final submission on 12 January 2010 consisted of a transmittal letter, an Information Disclosure Statement (IDS), copies of some of the prior art cited in the IDS, and the fee for submission of an IDS. The transmittal letter consisted of five (5) pages. The Examiner will reference the pages as follows: Page 1 - "Certification Statement," Page 2—"Privacy Act Statement," Page 3 - "Statement Under 37 C.F.R. § 1.97(e)(1)," Page 4 - "Payment and/or Authorization to Charge Fees," and Page 5 - "Statement of Relevance of Non-English References Pursuant to 37 C.F.R. 1.98(a)(3)(i)."
7. On page 1, Applicants checked only the box for "Fee set forth in 37 CFR 1.17 (p) has been submitted herewith."
8. On page 3, Applicants state "[i]n accordance with 37 CFR Section 1.97(e)(1), the items identified in this Information Disclosure Statement ("IDS"), which were first cited in a

communication from a foreign patent office in a counterpart foreign application, are brought to the attention of the Office.”

9. On page 3, Applicants also state “[t]his IDS is believed to be timely and is submitted under 37 CFR 1.97(c)(1) after the mailing of a final office action.”

10. On page 3, Applicants further state “[e]ach item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS.”

11. On page 5, Applicants state “[t]he non-English references JP 2002-198957A, JP H11-194987A, JP Application No. 2002-308406 cited in the accompanying PTO/SB/08a were cited in the Japanese Official Action issued for related JP Patent Application No. 2005-502636, which is also being submitted.”

12. On page 5, Applicants also state “[t]he non-English reference of Korean Laid-Open Patent Publication No. 2002- 0029657 cited in the accompanying PTO/SB/08a was cited in the Official Action issued for related KR Patent Application No, 10-2007-7006071, which is also being submitted.”

13. On page 5, Applicant further state “[t]he non-English reference of the Korean Official Action cited in the accompanying PTO/SB/08a was issued for related KR Patent Application No. 10-2007- 7006070.”

14. On the IDS received 12 January 2010 (“January 2010 IDS”) the only action from the Japanese Patent Office for application 2005-502636 is Non-Patent Literature Cite 6. The date provided for this document is August 3, 2009.

15. On the January 2010 IDS the only action from the Korean Patent Office for application 10-2007-7006071 is Non-Patent Literature Cite 5. The date provided for this document is May 26, 2009.

16. On the January 2010 IDS the only action from the Korean Patent Office for application 10-2007-7006070 is Non-Patent Literature Cite 5. The date provided for this document is June 2, 2009.

17. Applicants submitted an after final amendment on 24 February 2010 (February 2010 Amendment). The February 2010 Amendment added claim 71 and did not cancel any claims. Therefore, the February 2010 Amendment has not been entered.

18. The application has not been allowed.

19. In regards to the statements under 37 CFR § 1.97(e), MPEP § 609.04(b)(V) states “[t]he date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner.”

#### ***Information Disclosure Statements***

20. The January 2010 IDS fails to fully comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 for the reasons set forth below.

21. In order for an IDS to be considered after a final rejection, Applicant must (1) file the IDS on or before payment of the issue fee (37 CFR § 1.97(d)), (2) submit the fee set forth in 37 CFR § 1.17(p) (37 CFR § 1.97(d)(2)), and (3) make the statement specified under 37 CFR § 1.97(e) (37 CFR § 1.97(d)(1)).
22. As noted above in Paragraph 16, the application has not been allowed, therefore no issue fee has been paid. Thus, Applicants satisfy (1) above.
23. As noted in Paragraph 5, Applicants have paid the fee under 37 CFR § 1.17(p). Thus, Applicants comply with (2) above.
24. As noted in Paragraph 6, Applicants only checked the box on Page 1 of the transmittal letter to indicate the fee was paid. Applicants did not check the boxes on Page 1 for certification under either 37 CFR §1.97(e)(1) or 37 CFR § 1.97(e)(2).
25. As noted in Paragraphs 7 and 9, Applicants make statements which, when taken together, meet the provisions of 37 CFR § 1.97(e)(1). Therefore, Applicants appear to have complied with (3) above.
26. However, as noted in Paragraph 10, Applicants stated “[t]he non-English references JP 2002-198957A, JP H11-194987A, JP Application No. 2002-308406 cited in the accompanying PTO/SB/08a were cited in the Japanese Official Action issued for related JP Patent Application No. 2005-502636.” As noted in Paragraph 13, the only action from the Japanese Patent Office for application 2005-502636 is Non-Patent Literature Cite 6 and the date provided for this document is August 3, 2009. Also, the dates used to determine the 3-month period are the mailing date of the foreign action and the receipt date of the IDS, as discussed in Paragraph 17.

27. Because Applicants indicate that the references JP 2002-198957A, JP H11-194987A, and JP Application No. 2002-308406 were cited on the action for application 2005-502636 and because the action for application 2005-502636 is provided with a mail date of August 3, 2009, which is over five (5) months prior to the submission of the January 2010 IDS, it is the Examiner's position that the statement under 37 CFR § 1.97(e)(1) is inaccurate for these references. Because the statement appears inaccurate for these references and because the statement is needed for consideration of the references in an after final IDS, the Examiner has not considered these references and has crossed through them on the attached 1449.

28. Also, as noted in Paragraph 11, Applicants stated "[t]he non-English reference of Korean Laid-Open Patent Publication No. 2002- 0029657 cited in the accompanying PTO/SB/08a was cited in the Official Action issued for related KR Patent Application No, 10-2007-7006071" As noted in Paragraph 14, the only action from the Korean Patent Office for application 10-2007-7006071 is Non-Patent Literature Cite 5 and the date provided for this document is May 26, 2009. Also, the dates used to determine the 3-month period are the mailing date of the foreign action and the receipt date of the IDS, as discussed in Paragraph 17.

29. Because Applicants indicate that the Korean Laid-Open Patent Publication No. 2002-0029657 was cited on the action for application 10-2007-7006071 and because the action for application 10-2007-7006071 is provided with a mail date of May 26, 2009, which is over seven (7) months prior to the submission of the January 2010 IDS, it is the Examiner's position that the statement under 37 CFR § 1.97(e)(1) is inaccurate for these references. Because the statement appears inaccurate for these references and because the statement is needed for consideration of

the references in an after final IDS, the Examiner has not considered these references and has crossed through them on the attached 1449.

30. Furthermore, as noted in Paragraph 12, Applicants stated “[t]he non-English reference of the Korean Official Action cited in the accompanying PTO/SB/08a was issued for related KR Patent Application No. 10-2007-7006070.” As noted in Paragraph 15, the only action from the Korean Patent Office for application 10-2007-7006070 is Non-Patent Literature Cite 2 and the date provided for this document is June 2, 2009. Also, the dates used to determine the 3-month period are the mailing date of the foreign action and the receipt date of the IDS, as discussed in Paragraph 17.

31. Because Applicants indicate that the Korean Official Action was cited on the action for application 10-2007-7006070 and because the action for application 10-2007-7006070 is provided with a mail date of June 2, 2009, which is over seven (7) months prior to the submission of the January 2010 IDS, it is the Examiner’s position that the statement under 37 CFR § 1.97(e)(1) is inaccurate for this reference. Because the statement appears inaccurate for this reference and because the statement is needed for consideration of the references in an after final IDS, the Examiner has not considered this reference and has crossed through it on the attached 1449.

32. Moreover, the Examiner cannot find the action from the Korean Patent Office for application 10-2007-7006070 in the submission from Applicants.

33. The January 2010 IDS also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. For the references indicated as Non-Patent Literature Documents, Cites 1 and 3, Applicants have not made a concise statement as to their relevance. Therefore, these references have not been considered.

34. In summary, the January 2010 IDS has been placed in the application file, but the references crossed through by the Examiner have not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

35. The IDS submitted on 5 March 2010 (March 2010 IDS) references four (4) US Patents, two (2) US Patent Application Publications, and two (2) US Office Actions. Applicants state on the accompanying transmittal letter that "[i]n accordance with 37 CFR Section 1.97(e)(1), the items identified in this Information Disclosure Statement ("IDS"), which were first cited in a communication from the USPTO in a related application are brought to the attention of the Office" (Statement Under 37 C.F.R. § 1.97(e)(1)). This is not a proper statement under 37 CFR



§ 1.97(c)(1). Because the IDS contains US Patents, Publications, and Office Actions, the Examiner's position is that this statement is factually correct.

36. However, Applicants also state "[e]ach item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS" (Filing Provision). This statement contradicts the previous statement noted in Paragraph 35. Because the Examiner's position is that the previous statement is correct, it is necessarily his position that the statement noted in this paragraph is inaccurate.

37. Because the March 2010 IDS was filed after a final action and because the statement under 37 CFR 1.97(c)(1) is deemed inaccurate, the March 2010 IDS has not been considered.

#### ***Response to Amendment***

38. While the February 2010 Amendment has not been entered, the Examiner did look at the subject matter of proposed claim 71. The Examiner suggests incorporating the subject matter of proposed claim 71 into claim 1. The incorporation of this subject matter into claim 1 would likely overcome the current rejections. However, further search and consideration would be needed to determine patentability.

#### ***Conclusion***

39. The period for response is indicated on the attached PTO-303.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

41. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621